

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:)	
Inventor: KARP, Christoph D., et al.) Group Art Unit: 2855	
Serial No.: 10/697,923	Examiner: CYGAN, Michael T.	
Filed: October 29, 2003)) Attorney Docket: 131-US)	
For: PRESSURIZED MICROFLUIDIC DEVICES WITH OPTICAL DETECTION REGIONS)))	

DECLARATION OF STEPHEN D. O'CONNOR IN SUPPORT OF RESPONSE TO OFFICIAL ACTION MAILED APRIL 14, 2005

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

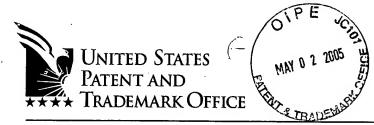
- 1. My name is Stephen D. O'Connor, and I am the President and CEO of Nanostream, Inc. I founded Nanostream in February 1999, and have held the positions of President and CEO since the company's inception.
- 2. Each employee of Nanostream, Inc. is required to sign an employment agreement at the time the employee is hired by Nanostream. Every employment agreement includes provisions obligating the employee to assign to Nanostream, Inc. any and all inventions made during the course of their employ at Nanostream.
- 3. In the case of the present application, U.S. serial number 10/697,923 entitled "Pressurized Microfluidic Devices With Optical Detection Regions," an assignment to Nanostream, Inc. was executed by both co-inventors on February 11,

2004. I understand that this assignment was subsequently recorded by the USPTO at Reel 014986 and Frame 0944. True and correct copies of the assignment of U.S. application serial number 10/697,923 and related USPTO recordation documents are attached hereto as Exhibit A.

- 4. In the case of a previous application, U.S. serial number 10/256,505 entitled "Frit Material and Bonding Method for Microfluidic Separation Devices," an assignment to Nanostream, Inc. was executed by the two co-inventors on September 27, 2002. I understand that this assignment was subsequently recorded by the USPTO at Reel 013345 and Frame 0923. I also understand that this application serial number 10/256,505 matured into U.S. Patent No. 6,814,859 on November 9, 2004. True and correct copies of the assignment of U.S. application serial number 10/256,505 and related USPTO recordation documents are attached hereto as Exhibit B.
- 5. I declare under penalty of perjury that the facts set forth in this declaration are true and correct, that all statements made of my own knowledge are true, and that all statements made on information and belief are believed to be true. I have been hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration.

Executed at Pasadena, California, this 2ℓ day of April, 2005.

Stephen D. O'Connor President and CEO Nanostream. Inc.



JANUARY 10, 2003

PTAS

NANOSTREAM, INC. VINCENT K. GUSTAFSON 580 SIERRA MADRE VILLA AVE. PASADENA, CA 91107 Under Secretary of Commerce For Intellectual Property and Director of the United States Patent and Trademark Office Washington, DC 20231 www.uspto.gov



UNITED STATES PATENT AND TRADEMARK OFFICE NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 09/27/2002

REEL/FRAME: 013345/0923

NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

KOEHLER, JEFFREY A.

DOC DATE: 09/27/2002

ASSIGNOR:

PATEL, PAREN P.

DOC DATE: 09/27/2002

ASSIGNEE:

NANOSTREAM, INC. 580 SIERRA MADRE VILLA

PASADENA, CALIFORNIA 91107

SERIAL NUMBER: 10256505

FILING DATE: 09/27/2002

PATENT NUMBER: ISSUE DATE:

MARY BENTON, EXAMINER ASSIGNMENT DIVISION OFFICE OF PUBLIC RECORDS

	OIPE 00 10-04-2	000			
	FORM PTO-1595 1-31-92. MAY 0 2 2005	U.S. DEPARTMENT OF COMMERCE			
	Docket No. NS-118 Div 1				
	To the Honorable Commissioner of ate. 1022416	ched original documents or copy thereof 2. Name and address of receiving party:			
	Jeffrey A. Koehler, Paren P. Patel	Name: Nanostream, Inc.			
	Additional name(s) of conveying party(ies) attached?	22.0			
	☐ Yes ☒ No 3. Nature of conveyance:	Internal Address:			
		City:State: Zip:			
	☐ Security Agreement ☐ Change of Name	2000			
	Other	Street Address: 580 Sierra Madre Villa			
		City: Pasadena State: California Zip: 91107			
	Execution Date: September 27, 2002				
	4. Application number(s) or patent number(s):	Additional name(s) & address(es) attached? Yes No			
		n, the execution date of the application is: September 27, 2002			
	A. Patent Application No(s).:	B. Patent No(s).:			
	10 256 505 Additional numbers att	l ached?□ Yes ⊠ No			
	5. Name and address of party to whom correspondence	6. Total number of applications and patents involved: 1			
	concerning document should be mailed:	_			
	Name: Vincent K. Gustafson	7. Total fee (37 CFR 3.41): \$40.00			
	Internal Address: Nanostream, Inc.	⊠ Enclosed			
	580 Sierra Madre Villa Ave. Pasadena, CA 91107	☐ Charge this Deposit Account if any additional fee is required			
		8. Deposit Account Number:			
	DO NOT USE	THIS SPACE			
	9. Statement and signature:				
	To the best of my knowledge and belief, the foregoing informat original document.	ion is true and correct and any attached copy is a true copy of the			
,		Date: 9/27/02			
	Michael F. Labbee, Reg. No. 39,738	Date.			
		including cover sheet: <u>3</u>			
	OMB No. 0651-0011 (exp. 4/94)				
	ONID 110. 0001 0011 (0xp. 4/04)				
Do not detach this portion Mail documents to be recorded with required cover sheet information to:					
	•	t and Trademark Office			
10	(01\500\5 KU50KHU1 00000041 10520202	ignments , D.C. 20231			
03	FC:581 40.00 OP Washington	, D.C. 20231			
	Public burden reporting for this sample cover sheet is estimated including time for reviewing the document and gathering the da Send comments regarding this burden estimate to the U.S. Pat 1000C, Washington, D.C. 20231, and to the Office of Manager Washington, D.C. 20503	ta needed, and completing and reviewing the sample cover sheet. ent and Trademark Office, Office of Information Systems, PK2-			

ASSIGNMENT

For good and valuable consideration, the receipt of which is hereby acknowledged, we, the undersigned, inventors:

Jeffrey A. Koehler, 1270 Cordova St #20, Pasadena, CA 91106

Paren P. Patel, 90 Suffolk Ave. #7, Sierra Madre, CA 91024

who have created a certain invention for which an application for United States Letters Patent entitled FRIT MATERIAL AND BONDING METHOD FOR MICROFLUIDIC SEPARATION DEVICES has been executed and

\boxtimes	is filed herewith;	
∏ ¢	was filed in the U.S. Patent and Trademark Office on;	and

Do hereby sell, assign and transfer to Nanostream, Inc., a Delaware corporation having a place of business at 580 Sierra Madre Villa, Pasadena, California 91107, its successors, assigns, and legal representatives, the full and exclusive right to said invention and said application and to any and all inventions described in said application for the United States, its territorial possessions and all foreign countries, and the entire right, title and interest in and to any and all Letters Patent which may be granted therefore in the United States, its territorial possessions and all foreign countries; and in and to any and all continuations-in-part, continuations, divisions, substitutes, reissues, extensions thereof, and all other applications for Letters Patent relating thereto which have been or shall be filed in the United States, its territorial possession and/or any foreign countries, and all rights, together with all priority rights, under any of the international conventions, unions, agreements, acts, and treaties, including all future conventions, unions, agreements, acts, and treaties; and

Agree that Nanostream, Inc., hereinafter referred to as Assignee, may apply for and receive Letters Patent for said invention and said inventions, hereinafter referred to as said invention, in its own name, in the United States, its territorial possessions, and all foreign countries; and that, when requested to carry out in good faith the intent and purpose of this assignment, at the expense of said Assignee, its successors, assigns and legal representatives, the undersigned will execute all continuations-in-part, continuations, divisions, substitutes, reissues, extensions thereof, execute all rightful oaths, assignments, powers of attorney and other papers, testify in any legal or quasi legal proceedings; communicate to said Assignee, its successors, assigns or legal representatives all facts known to the undersigned relating to said invention and the history thereof; and generally do everything possible which said Assignee, its successors, assigns, or legal representatives shall consider desirable for aiding in securing, maintaining and enforcing proper patent protection for said invention and for vesting title to said invention and all applications for patents on said invention in said Assignee, successors, assigns, or legal representatives;

The terms "Application" and Application for Letters Patent" as used herein include both provisional and non-provisional applications;

Inventor(s) hereby authorizes the above-mentioned Assignee or its legal representative to insert in this instrument the filing date and serial number of said Application or any other information that may be necessary or desirable in order to comply with the rules of the United States Patent and Trademark Office for recordation of this document; and

Covenant with said Assignee, its successors, assigns, or legal representatives that no assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been made to others by the undersigned, and that full right to convey the same has herein expressed is possessed by the undersigned.

IN THE TESTIMONY WHEREOF I have hereunto set my signature on the date indicated below.

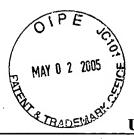
JEFFREY A. KOEHLER

Ďate:

PAREN P. PATEL

Date:

09/27/02





UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

AUGUST 14, 2004

PTAS

102674706A

NANOSTREAM, INC. VINCENT K. GUSTAFSON 580 SIERRA MADRE VILLA AVENUE PASADENA, CA 91107-2928

UNITED STATES PATENT AND TRADEMARK OFFICE NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 02/17/2004

REEL/FRAME: 014986/0944

NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

KARP, CHRISTOPH D.

DOC DATE: 02/11/2004

ASSIGNOR:

PATEL, PAREN P.

DOC DATE: 02/11/2004

ASSIGNEE:

NANOSTREAM, INC.

580 SIERRA MADRE VILLA AVENUE PASADENA, CALIFORNIA 91107

SERIAL NUMBER: 10697923

FILING DATE: 10/29/2003

PATENT NUMBER: ISSUE DATE:

TITLE: PRESSURIZED MICROFLUIDIC DEVICES WITH OPTICAL DETECTION REGIONS

014986/0944 PAGE 2

MARGARET LASALLE, PARALEGAL ASSIGNMENT DIVISION OFFICE OF PUBLIC RECORDS

	FEB 1 7 2002 MAY 0 2 2005 H	(
	RM PTO-1595	2004 U.S. DEPARTMENT OF COMMERCE		
OM	v. 10/02 - modified) B No. 0651-0027 (exp. 6/8005)	Patent and Trademark Office		
Doc	Docket No. 131-US			
	To the Honorable Commissioner of Patence and requestrations.	1706 record the attached original documents or copy thereof.		
1.	Name of conveying party(les):	2. Name and address of receiving party:		
	Christoph D. Karp	Nama: Namastraam Inc		
	Paren P. Patel	Name: Nanostream, Inc.		
	Additional name(s) of conveying party(ies) attached? Yes No	Internal Address:		
3.	Nature of conveyance:	City:State: Zip:		
	☐ Security Agreement ☐ Change of Name	Street Address: 580 Sierra Madre Villa Avenue		
	☐ Other	City: Pasadena State: California Zip: 91107-2928		
	Execution Date: February 11, 2004	Additional name(s) & address(es) attached? No		
4.	Application number(s) or patent number(s):			
	If this document is being filed together with a new appl			
	A. Patent Application No(s).: 10/697,923	B. Patent No(s).:		
		·		
Additional numbers attached? ☐ Yes ☒ No				
5.	Name and address of party to whom correspondence concerning document should be mailed:	6. Total number of applications and patents involved: 1		
	Name: Vincent K. Gustafson	7. Total fee (37 CFR 3.41): \$ 40.00		
	Internal Address:	Authorization to charge Deposit Account Number 502454.		
	Street Address: Nanostream, Inc.	Charge this Deposit Account if any additional fee is required		
	580 Sierra Madre Villa Avenue			
	Pasadena, CA 91107-2928	8. Deposit Account Number: 502454		
23/20	04 DBYRNE 00000013 502454 10697923	THE ODAOF		
FC:80 9.	21 40.00 DA DO NOT USE Signature	THIS SPACE		
Vincent K. Gustafson, Reg. No. 46.182 Name of Person Signing Vint X Gustafson, February 11, 2004 Signature Date				
Total number of pages including cover sheet, attachments, and documents: 3				

Nanostream, Inc. Docket No. 131-US

ASSIGNMENT

For good and valuable consideration, the receipt of which is hereby acknowledged, we, the undersigned, inventors:

Christoph D. Karp, 335 South Grand Oaks Avenue, Pasadena, CA 91107, USA

Paren P. Patel, 90 Suffolk Avenue #7, Sierra Madre, CA 91024, USA

who have created a certain invention for which an application for United States Letters Patent entitled **PRESSURIZED MICROFLUIDIC DEVICES WITH OPTICAL DETECTION REGIONS** has been executed and

	is filed herewith;	
\boxtimes	was filed in the U.S. Patent and Trademark Office on October 29, 20 assigned Serial Number 10/697,923;	<u>03</u> and

Do hereby sell, assign and transfer to Nanostream, Inc., a Delaware corporation having a place of business at 580 Sierra Madre Villa Avenue, Pasadena, California 91107-2928, its successors, assigns, and legal representatives, the full and exclusive right to said invention and said application and to any and all inventions described in said application for the United States, its territorial possessions and all foreign countries, and the entire right, title and interest in and to any and all Letters Patent which may be granted therefore in the United States, its territorial possessions and all foreign countries; and in and to any and all continuations-in-part, continuations, divisions, substitutes, reissues, extensions thereof, and all other applications for Letters Patent relating thereto which have been or shall be filed in the United States, its territorial possession and/or any foreign countries, and all rights, together with all priority rights, under any of the international conventions, unions, agreements, acts, and treaties, including all future conventions, unions, agreements, acts, and treaties; and

Agree that Nanostream, Inc., hereinafter referred to as Assignee, may apply for and receive Letters Patent for said invention and said inventions, hereinafter referred to as said invention, in its own name, in the United States, its territorial possessions, and all foreign countries; and that, when requested to carry out in good faith the intent and purpose of this assignment, at the expense of said Assignee, its successors, assigns and legal representatives, the undersigned will execute all continuations-in-part, continuations, divisions, substitutes, reissues, extensions thereof, execute all rightful oaths, assignments, powers of attorney and other papers, testify in any legal or quasi legal proceedings; communicate to said Assignee, its successors, assigns or legal representatives all facts known to the undersigned relating to said invention and the history thereof; and generally do everything possible which said Assignee, its successors, assigns, or legal representatives shall consider desirable for aiding in securing, maintaining and enforcing proper patent protection for said invention and for vesting title to said invention and all applications for patents on said invention in said Assignee, successors, assigns, or legal representatives;

The terms "Application" and "Application for Letters Patent" as used herein include both provisional and non-provisional applications;

Nanostream, Inc. Docket No. 131-US

Inventor(s) hereby authorizes the above-mentioned Assignee or its legal representative to insert in this instrument the filing date and serial number of said Application or any other information that may be necessary or desirable in order to comply with the rules of the United States Patent and Trademark Office for recordation of this document; and

Covenant with said Assignee, its successors, assigns, or legal representatives that no assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been made to others by the undersigned, and that full right to convey the same has herein expressed is possessed by the undersigned.

IN THE TESTIMONY WHEREOF I have hereunto set my signature on the date indicated below.

CHRISTOPH D. KARP

Date:

te: 2 (1) 0

2.11.04

PAREN P. PATEL

Date: